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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,319	12/30/1999	TAKAYUKI HASEBE	P21-9028	7660

32294 7590 11/04/2002

SQUIRE, SANDERS & DEMPSEY L.L.P.  
14TH FLOOR  
8000 TOWERS CRESCENT  
TYSONS CORNER, VA 22182

EXAMINER

BARRON JR, GILBERTO

ART UNIT PAPER NUMBER

2132

DATE MAILED: 11/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/476,319

Applicant(s)

HASEBE ET AL.

Examiner

Gilberto Barrón Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-56 and 111-125 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-56 and 111-125 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/031,339.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Response to Amendment***

1. The Amendment filed on August 23, 2002 has been carefully considered. This amendment and the personal interview conducted on August 15, 2002 have overcome several of the grounds of rejection previously set forth in the Final Office action mailed October 24, 2001. In particular the grounds of rejection based on the Matyas reference are herein withdrawn. However, the rejection under §101 for an invention claimed as non-statutory subject matter has not been overcome. Further, new grounds of rejection under §251 for claims not directed to the original invention and under the prohibition for recapture of surrendered subject matter are raised. These grounds of rejection are presented below.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 101***

3. Claims 1-56 and 111-125 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The instant claims are directed to non-functional descriptive matter. Non-functional descriptive matter is that which exhibits no functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. The instant claims recite a storage

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medium with two or three storage areas. However, none of the storage areas provide for descriptive matter that provides for a functionality either to the data as structured or a process to be implemented on a computer. The claims seek to patent a storage medium that is a repository for specific type data, but that data is not functional in nature. The data on the storage medium is solely to be acted on by another process when imparted to a computer.

The original patent application 08/603,760 amended the pending claims by adding to the preamble "accessed by a vendor computer and user computer, said storage medium" .... "information readable by said user computer, said storage medium" to overcome the 101 non-statutory rejection raised at that time. However, it is not clear that the claims of this reissue application provide for functional descriptive matter, either with claims that still retain the preamble that was originally amended or with the newly added claims that do not have the amendatory language.

#### ***Claim Rejections - 35 USC § 251 - Recapture***

4. Claims 24-28, 34-39, 44-56 and 119-125 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of

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the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The original patent application 08/603,760 amended all the independent claims 13, 18 and 23 (now patent claims 1, 6 and 11) by adding to the preamble "accessed by a vendor computer and user computer, said storage medium" .... "information readable by said user computer, said storage medium" to overcome a 101 non-statutory rejection raised at that time. The instant claims 24-28, 34-39, 44-56 and 119-125 now do not carry that limitation. Since Applicant surrendered that subject matter, the recapture of that subject matter, as would be done by allowance of these claims, is improper.

5. Claims 1-10 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the

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narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The instant claims were allowed based on an amendment which provided for "generating a decryption key" or "generating an encrypted permission key", which limitations are now being sought to be eliminated. The attempted recapture is improper.

***Claim Rejections - 35 USC § 112***

6. Claims 17-20, 24, 25, 39-46, 49-56 and 119-125 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims are vague and indefinite because the distinction between encrypted information and encrypted data or information that is encrypted is not clear. The claims confuse the encrypted decryption key or encrypted permission information with the encrypted information or data. The description of the invention provides for the encrypted permission information or encrypted decryption key as encrypted based on the medium personal number, while the encrypted information or data is encrypted with the decryption key. The instant claims confuse the two sets of encrypted information.

***Claim Rejections - 35 USC § 251 – Not Original Invention***

7. Claims 29-33, 35, 39-47, 49-56, 124 are rejected under 35 U.S.C. 251 as being directed to an invention that was not disclosed in the original patent.

The instant claims do not recite a third storage area on a storage medium for encrypted information, or electronic data, that is encrypted with the decryption key. These claims solely claim a storage medium having a storage area for a medium personal number and a storage area for information encrypted based on the medium personal number. The original disclosure did not describe any embodiment in which a storage medium solely provided for a storage area for a medium personal number and a storage area for information encrypted based on the medium personal number. Nowhere did the original disclosure describe utility or the advantage or the result of an embodiment without a third storage area for encrypted information or data encrypted based on a decryption key. In particular, the utility and advantage of protecting the electronic data from being illegally copied by a third party, see page 1, lines 5-29, of the original specification, would not be achieved with an embodiment where no data or software or information is present to be protected.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (703) 305-1830. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

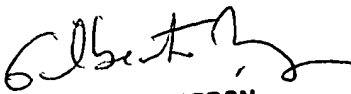
If attempts to reach the examiner by telephone are unsuccessful, Mr. Albert Decady, who can be reached on (703) 305-9595, or Ms. Gail Hayes, who can be reached on (703) 305-9711, may be contacted.

The fax phone number for OFFICIAL responses for the organization where this application or proceeding is assigned is (703) 746-7239.

The fax phone number for AFTER FINAL responses for the organization where this application or proceeding is assigned is (703) 746-7238.

The fax phone number for DRAFT proposals for the organization where this application or proceeding is assigned is (703) 746-7240

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
**GILBERTO BARRON**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**